

# ***Markman v. Westview: Juries and Patent Infringement Suits*** **(or Why Is That Jury in the Courtroom, Anyway?)**

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“[T]he patent system . . . added the fuel of *interest* to the *fire* of genius, in the discovery and production of new and useful things.”\*\*

## I. INTRODUCTION

*Markman v. Westview Instruments, Inc.*<sup>1</sup> started life as a fairly typical patent infringement suit. The patent holders, Herbert Markman and Positek, Inc., sued the defendants, Westview Instruments, Inc. and Althon Enterprises, Inc., for using a patented invention<sup>2</sup> without permission.<sup>3</sup> The key issue was a common one in patent suits—the meaning of a term in the allegedly infringed claims.<sup>4</sup> However, the Federal Circuit Court of Appeals<sup>5</sup> en banc opinion for

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\* I would like to thank Patricia L. Prior, Esq., for her assistance with this project. Defects, if any, are attributable to me alone. I would also like to thank my family and friends for their support.

\*\* President Lincoln made this comment in a speech before the Phi Alpha Society of Illinois College delivered at Jacksonville in 1859. See Abraham Lincoln, *Second Lecture on Discoveries and Inventions*, in 3 THE COLLECTED WORKS OF ABRAHAM LINCOLN 356, 363 (R.P. Basler ed. 1953).

<sup>1</sup> *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535 (E.D. Pa. 1991), *aff'd*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996).

<sup>2</sup> “Inventory Control and Reporting System for Drycleaning Stores,” U.S. Reissue Patent No. 33,054 [hereinafter ‘054 patent], issued on Sept. 12, 1989, 1106 U.S. DEP’T OF COMMERCE, PATENT & TRADEMARK OFFICE, OFFICIAL GAZETTE OF THE U.S. PATENT & TRADEMARK OFFICE 760–61 (1989) [hereinafter OFFICIAL GAZETTE] as a reissue of U.S. Patent No. 4,550,246 issued on Oct. 29, 1985. 1059 OFFICIAL GAZETTE, *supra*, at 2287. See *infra* note 27 for an explanation of reissue patents.

<sup>3</sup> See *Markman*, 772 F. Supp. at 1536–37.

<sup>4</sup> See *id.* Claims are the part of a patent that give patent holders their legal rights. See *infra* notes 35–36 and accompanying text.

<sup>5</sup> The Court of Appeals for the Federal Circuit was created by the Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, § 101, 96 Stat. 25 (codified in scattered sections of 28 U.S.C.). The Federal Circuit has exclusive jurisdiction over all appeals in patent cases from all district courts. See 28 U.S.C. § 1295(a)(1), (4)(C). It has national geographic jurisdiction in the patent area. See *id.*

this case,<sup>6</sup> which was affirmed by the United States Supreme Court,<sup>7</sup> sent shock waves through the intellectual property law profession.<sup>8</sup> The court ruled that the interpretation of language used in a patent claim is a matter of law solely for the court.<sup>9</sup>

As a result of the *Markman* ruling,<sup>10</sup> juries are entirely excluded from claim construction, one of the two steps in patent infringement analysis.<sup>11</sup> The ruling, therefore, has significant ramifications for patent litigation<sup>12</sup> and deserves close examination.

This Case Comment analyzes the *Markman* ruling in light of precedent, the Seventh Amendment, and various conceptions of patent infringement. In view of this analysis, the *Markman* ruling is largely correct.<sup>13</sup> However, one significant issue of fact that can affect the interpretation of the language used in a patent claim should remain for jury consideration.<sup>14</sup> This issue arises when the prosecution history<sup>15</sup> is unclear about the occurrence of events during the prosecution of the patent application. In that case, the issue of what actually transpired during prosecution should be left to the jury.<sup>16</sup>

This Case Comment is divided into eight parts. Part II is a brief overview of patents and patent infringement. This part is provided as a foundation for readers who do not have a patent background. Part III is a summary of the district court's decision, the Federal Circuit's decision, the Supreme Court's decision, and the issues in *Markman*. Part IV is a discussion of some of the ramifications of the *Markman* ruling. These ramifications range from the precedential value of claim language interpretation as a matter of law to the jury instructions used in litigation. Part V is an analysis of the relevant precedent, a good deal of which is in conflict. Part VI is a Seventh Amendment analysis of the *Markman* ruling. Part VII discusses analogies of patents to contracts and

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<sup>6</sup> See *Markman*, 52 F.3d at 967.

<sup>7</sup> See *Markman*, 116 S. Ct. at 1387.

<sup>8</sup> See *infra* Part IV.

<sup>9</sup> See *Markman*, 52 F.3d at 970-71, 979.

<sup>10</sup> The ruling that the interpretation of language used in patent claims is a matter of law solely for the courts is referred to as the *Markman* ruling throughout the rest of this Case Comment.

<sup>11</sup> See *infra* Part II.C.2.

<sup>12</sup> See *infra* Part IV.

<sup>13</sup> See *infra* Part VIII.

<sup>14</sup> Throughout this Case Comment, the factfinder is assumed to be a jury. However, the same principles apply when the factfinder is a judge.

<sup>15</sup> Prosecution history refers to the record of the proceedings before the Patent and Trademark Office in acquiring a patent. See *infra* Part II.C.1.

<sup>16</sup> See *infra* notes 247-58 and accompanying text.

statutes. These analogies are necessary both to settle the Seventh Amendment issue and to determine the proper way to interpret claim language. Part VIII is the conclusion.

## II. A BRIEF SURVEY OF PATENT LAW

This Part is intended as a basic survey for the reader who is unfamiliar with patent law. Basically, a patent is a grant by the federal government to an inventor for the “right to exclude others from making, using, offering for sale, or selling” their invention.<sup>17</sup> While the following material is accurate, it is also somewhat cursory.<sup>18</sup>

### A. *Why Do We Have Patents?*

The patent system encourages inventors to invent by granting them exclusive rights to their inventions for a limited time. These rights are often assigned to the corporations that funded the inventors’ activities, thereby rewarding the corporations for encouraging invention and encouraging the development of new technologies. These new technologies lead to new jobs, new industries, new consumer goods, and trade benefits.<sup>19</sup> Thus, the interests of the public are served by rewarding inventors’ efforts with patents.<sup>20</sup>

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<sup>17</sup> See *infra* Part II.C.2 for a discussion of infringement, the use of a patented invention by someone other than the patent holder or an assignee.

<sup>18</sup> The interested reader should consult any of the following treatises for a more thorough discussion of patent law: DONALD S. CHISUM, *PATENTS* (1993) (providing a continuously updated multi-volume loose leaf exposition on patents); ROBERT L. HARMON, *PATENTS AND THE FEDERAL CIRCUIT* (3d ed. 1994) (focusing on the treatment of patent law by the Court of Appeals for the Federal Circuit); RONALD B. HILDRETH, *PATENT LAW: A PRACTITIONER’S GUIDE* (1988) (focusing on issues relevant to the practitioner); ERNEST BAINBRIDGE LIPSCOMB III, *LIPSCOMB’S WALKER ON PATENTS* (3d ed. 1984) (providing a more extensive eleven volume survey of the field); THOMAS TERRELL, *THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS* (1991).

<sup>19</sup> See *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 876–77 (Fed. Cir. 1985), *cited in* HARMON, *supra* note 18, § 1.2, at 8.

<sup>20</sup> See TERRELL, *supra* note 18, at 1. The concept of serving the public good by means of rewarding inventors is not new. Long before the United States even existed, Venice and England had provisions for patents. The first modern patent statute was enacted in Venice around 1432. See WILLIAM H. FRANCIS & ROBERT C. COLLINS, *CASES AND MATERIALS ON PATENT LAW* 5 (4th ed. 1995). Roughly 200 years later, England passed the Statute of Monopolies to restrict the overly common and corrupt granting of monopolies by the crown. Statute 21, James I, ch. 3 (1623), *cited in* FRANCIS & COLLINS, *supra*, at 69. Grants of

## B. *The Constitution*

Article I, section 8, clause 8 of the Constitution of the United States grants Congress "the Power To . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>21</sup> Note that the purpose of this grant of power is expressly incorporated into the clause. As long as Congress acts in accordance with this purpose, it can select the "policy which in its judgment best effectuates the constitutional aim."<sup>22</sup>

## C. *Modern Patent Law in the United States*

Current patent laws are set forth in Title 35 of the *United States Code*.<sup>23</sup> The Commissioner of Patents and Trademarks has authority from Congress to establish rules and regulations for the prosecution of patent applications.<sup>24</sup> These rules and regulations are set forth in Title 37 of the *Code of Federal Regulations*.<sup>25</sup> The *Manual of Patent Examining Procedures* sets forth detailed procedures to be followed during patent prosecution.<sup>26</sup>

### 1. *Acquiring a Patent*

In order to acquire a patent,<sup>27</sup> an inventor must file a patent application<sup>28</sup> with the United States Patent and Trademark Office.<sup>29</sup>

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letters-patent to inventors were expressly exempted from the restrictions created by the Statute of Monopolies. *See id.* The concept that patents for inventions serve the public good was also considered to be important enough to be incorporated into the United States Constitution in 1789. U.S. CONST. art. I, § 8, cl. 8.

<sup>21</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>22</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

<sup>23</sup> *See HILDRETH, supra* note 18, at 3.

<sup>24</sup> *See id.* Patent prosecution refers to the proceedings related "to the granting and issuing of patents." *Id.*

<sup>25</sup> *See id.*

<sup>26</sup> *See id.*

<sup>27</sup> Several types of patents exist: utility patents, design patents, and plant patents. *See HILDRETH, supra* note 18, at 5-7. The focus of this Case Comment is on *utility patents*, which are acquired for inventions. *See* 35 U.S.C. § 101 (1994) ("Whoever invents or discovers any new or useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."). *Design patents* cover new, original, and ornamental designs of articles of manufacture. *See* 35 U.S.C. § 171 (1994). *Plant patents* cover invented or

Basically, an application consists of a specification describing the invention,<sup>30</sup> drawings if necessary for understanding the invention,<sup>31</sup> models or specimens if required by the Commissioner,<sup>32</sup> a fee<sup>33</sup> (of course), and an oath.<sup>34</sup> The specification must conclude with "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."<sup>35</sup> The claims are

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discovered distinct and new varieties of asexually reproduced plants. See 35 U.S.C. § 161 (1994).

The particular patent at issue in *Markman* was a reissued utility patent. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970 (Fed. Cir. 1995). Patents can be reissued to correct errors that occur "without deceptive intent." See 35 U.S.C. § 251 (1994). The pertinent statute reads:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

*Id.*

<sup>28</sup> The requirements for a patent application are set forth in 35 U.S.C. §§ 111-15 (1994).

<sup>29</sup> See HILDRETH, *supra* note 18, at 4. The application must be sent to the Commissioner of Patents and Trademarks in Washington, D.C. *Id.*

<sup>30</sup> See 35 U.S.C. § 112 (1994). The specification must be "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." *Id.*, ¶ 1.

<sup>31</sup> See 35 U.S.C. § 113 (1994).

<sup>32</sup> See 35 U.S.C. § 114 (1994). This requirement is rarely imposed except when the invention is a composition of matter or when the examiner doubts the operability of the invention, *e.g.*, in the cases of a perpetual motion machine. See Al Lawrence Smith, *Patent Solicitation*, in FUNDAMENTALS OF PATENT LAW AND PRACTICE 1993, at 25, 35 (ALI-ABA Course of Study Series No. C805, 1993).

<sup>33</sup> See 35 U.S.C. § 41 (1994).

<sup>34</sup> See 35 U.S.C. § 115 (1994).

<sup>35</sup> 35 U.S.C. § 112, ¶ 2 (1994). Claims were not required in patent applications until the Patent Act of 1870, ch. 230, § 26, 16 Stat. 198. Claims that are ambiguous or unduly broad will be ruled invalid in an infringement suit. See HARMON, *supra* note 18, § 5.4, at 157. However, claims that appear to be ambiguous will, whenever possible, be construed to preserve their validity. See *id.* at 157 n.124.

the part of any resulting patent that give the inventor his or her legal rights against infringers.<sup>36</sup>

An invention must be new,<sup>37</sup> useful,<sup>38</sup> and unobvious<sup>39</sup> when compared to the prior art<sup>40</sup> in order to be patentable. A delay in filing a patent application can result in a loss of patent rights.<sup>41</sup> In addition, patentability is limited by certain other restrictions. For example, laws of nature, physical phenomena, and abstract ideas cannot be patented.<sup>42</sup>

After the inventor files a patent application, a patent examiner at the Patent and Trademark Office determines whether or not the application is in condition for allowance.<sup>43</sup> If the examiner allows the application, then the inventor is granted a patent<sup>44</sup> after (surprise) payment of another fee.<sup>45</sup> If the examiner rejects the application, then the applicant can reply to the rejection by timely

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<sup>36</sup> See *infra* Part II.C.2.

<sup>37</sup> See 28 U.S.C. §§ 101–02 (1994). Section 101 actually states that the invention must be new, while the novelty requirement of § 102 qualifies § 101. An invention is not novel if it “was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” 35 U.S.C. § 102(a). An invention also is not novel if it “was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled [certain statutory requirements] before the invention thereof by the applicant for patent.” 35 U.S.C. § 102(e). When there has been a “complete anticipation” of the invention, it is not technically “new” and thus cannot be patented. See HILDRETH, *supra* note 18, at 55–57. “[T]hat which would literally infringe if later in time anticipates if earlier than the date of invention.” *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987); see also 35 U.S.C. § 102(g). See *infra* Part II.C.2 for more on infringement.

<sup>38</sup> See 35 U.S.C. § 101 (1994).

<sup>39</sup> See 35 U.S.C. § 103 (1994).

<sup>40</sup> The prior art includes any relevant knowledge, acts, descriptions, and patents that pertain to, but predate, the invention. See BLACK’S LAW DICTIONARY 1193 (6th ed. 1990).

<sup>41</sup> A patent will not issue if “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b). This restriction is called a “statutory bar.” See HARMON, *supra* note 18, § 3.5, at 89.

<sup>42</sup> See *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948); see also HARMON, *supra* note 18, §§ 2.1–2.2, at 33–43.

<sup>43</sup> See HILDRETH, *supra* note 18, at 30–31. A patent application is in condition for allowance if it meets all of the requirements for a patent to issue. See *id.*

<sup>44</sup> See *id.*

<sup>45</sup> See 35 U.S.C. § 41 (1994).

submitting a written amendment<sup>46</sup> to the application.<sup>47</sup> If the patent is allowed, the specification (including the claims) and drawings of the application become the specification and drawings of the patent.<sup>48</sup> This entire process, from the filing of the application to the allowance of the patent, is called the prosecution of the patent application.<sup>49</sup> The record of all of these proceedings forms the prosecution history.<sup>50</sup>

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<sup>46</sup> See HILDRETH, *supra* note 18, at 30–31, 190.

<sup>47</sup> See *id.* at 30–31. The applicant can not add any new matter to the specification or the claims in the amendment. See 35 U.S.C. § 132 (1994) (“No amendment shall introduce new matter into the disclosure of the invention.”). Within this limitation, the applicant can cancel, add, or rewrite the claims. See HILDRETH, *supra* note 18, at 190. The applicant can agree with the examiner’s objections or argue that the examiner’s reasoning is flawed. See *id.*

The applicant can also have a limited number of personal interviews with the examiner regarding the objections. See 37 C.F.R. § 1.133 (1996). Regardless of whether an agreement is reached between the examiner and applicant at the interview, however, “[a] complete written statement as to the substance of any face-to-face or telephone interview with regard to the merits of an application must be made of record in the application.” MANUAL OF PATENT EXAMINING PROCEDURE § 713.04, at 700–107 (1995); see also 37 C.F.R. § 1.133. The applicant, or the applicant’s agent or attorney, has the “responsibility . . . to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so.” 37 C.F.R. § 1.133. In this regard, the form that the examiner uses to record the substance of the interview, Form PTOL 413, includes a box that the examiner can check to indicate that “the applicant need not supplement the Form by submitting a separate record of the interview.” *Id.*

The amendment and rejection process is repeated until either the application is allowed or the examiner issues a “final rejection.” After a final rejection, the applicant may have the opportunity to file an “amendment after final rejection” to cancel claims or to comply with the examiner’s objections. See 37 C.F.R. § 1.116 (1996). If the application is rejected again or if the examiner refuses to accept the amendment, the applicant can appeal to the Board of Patent Appeals and Interferences. See HILDRETH, *supra* note 18, at 31–32. From there, the applicant can appeal to either the District Court for the District of Columbia or the Court of Appeals for the Federal Circuit. See *id.* Any ruling from the district court can be appealed to the Court of Appeals for the Federal Circuit. See *id.* An applicant can appeal an adverse decision thereby petitioning the United States Supreme Court. See *id.*

<sup>48</sup> See 35 U.S.C. § 154(a)(1)(4) (1994). The patent also has various other contents, such as the title of the invention and the grant of the patent to the patentee, his heirs, or assigns. See 35 U.S.C. § 154(a).

<sup>49</sup> See HILDRETH, *supra* note 18, at 30–32.

<sup>50</sup> The prosecution history is the record kept by the Patent and Trademark Office of the prosecution of a patent application. See 4 CHISUM, *supra* note 18, § 18.05, at 18–151. The prosecution history can also be referred to as the “file wrapper.” See *id.* The specification, claims, and prosecution history become part of the public record. See *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995).

## 2. Infringement

A patent grants the holder the "right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States."<sup>51</sup> Subject to maintenance fees,<sup>52</sup> this right lasts for twenty years from the date on which the patent application was filed in the United States.<sup>53</sup> When a person makes, uses, offers to sell, or sells any patented invention without permission, that person is liable to the patent holder for infringement.<sup>54</sup> The infringer may be liable for up to three times any actual damages, and in "exceptional cases," for attorney's fees.<sup>55</sup> The infringer may also be enjoined from performing further acts of infringement.<sup>56</sup>

Infringement analysis has two steps.<sup>57</sup> First, the scope and meaning of the allegedly infringed claim (or claims) must be determined.<sup>58</sup> The claim is construed in light of three factors: (1) the language of the claims, (2) the specification, and (3) the prosecution history.<sup>59</sup> The words of a claim are presumed to have their "ordinary and accustomed meaning" unless the specification or file history indicates that the inventor intended otherwise.<sup>60</sup>

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<sup>51</sup> 35 U.S.C. § 154(a)(1) (1994).

<sup>52</sup> See 35 U.S.C. § 41(b) (1994).

<sup>53</sup> See 35 U.S.C. § 154. On December 8, 1994, the patent term was changed from the previous 17 year term from the date of issue to the current 20 year term from the date of filing. This change was made in accordance with the General Agreement on Trade and Tariffs Treaty (GATT). See Pub. L. 103-465, Title V, § 532(a)(1), 108 Stat. 4983, 4990.

<sup>54</sup> See 35 U.S.C. § 271 (1994).

<sup>55</sup> See 35 U.S.C. §§ 284-85 (1994); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1579, 1585 (Fed. Cir. 1996); see also *Graco, Inc. v. Binks Mfg. Co.*, 60 F.3d 785, 792 (Fed. Cir. 1995).

<sup>56</sup> See 35 U.S.C. § 283 (1994).

<sup>57</sup> See *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821 (Fed. Cir. 1992).

<sup>58</sup> See *id.* Note that the *claims* are what are allegedly infringed, not the specification.

<sup>59</sup> See *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991) (citing *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 867 (Fed. Cir. 1985)); see also *Carrol Touch, Inc. v. Electro Mechanical Sys., Inc.*, 15 F.3d 1573, 1577 (Fed. Cir. 1993) (quoting *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1566 (Fed. Cir. 1992)).

<sup>60</sup> See *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759 (Fed. Cir. 1984) (citing *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 137 F.2d 3, 6 (7th Cir. 1943), *aff'd*, 322 U.S. 471 (1944)). In order to allow an inventor to have the flexibility necessary to describe new things, the inventor can give words new meanings that are different than their ordinary and accustomed ones. See *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 396 (Ct. Cl.



Extrinsic evidence, such as the testimony of experts, can also be used "to aid the court in the construction of the patent."<sup>61</sup> Second, the allegedly infringing device is compared to the properly construed claim.<sup>62</sup> The first step is often more important because a claim's construction is often determinative as to whether the claim is infringed.<sup>63</sup>

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1967), *cited in* *United States v. Teletronics, Inc.*, 857 F.2d 778, 781 (Fed. Cir. 1988). "[P]atent law allows the inventor to be his own lexicographer. . . . The sanction of [the creation of] new words or hybrids from old ones not only leaves one unsure what a rose is, but also unsure whether a rose is a rose." *Id.*

<sup>61</sup> *Brown v. Piper*, 91 U.S. 37, 41 (1875); *see also* *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 233 (1942); *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 545-46 (1870).

<sup>62</sup> *See Read*, 970 F.2d at 821. If the accused device embodies each and every limitation of the properly construed claim, then the device "literally infringes" the claim. *See Baxter Healthcare Corp. v. Specramed, Inc.*, 49 F.3d 1575, 1582 (Fed. Cir. 1995); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1577 (Fed. Cir. 1989). In order to prevent "the pirating of the patentee's invention in the absence of literal infringement when liability is nevertheless warranted," the courts have developed the "doctrine of equivalents." *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 876 (Fed. Cir. 1993) (citing *Hormone Res. Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1564 (Fed. Cir. 1990)). At the time that *Markman* was decided, "[i]nfringement under the doctrine of equivalents require[d] a showing that the accused device perform[ed] substantially the same function, in substantially the same way, to achieve substantially the same result as the patented device." *Graver Tank & Mfg. Co., v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950). "The essence of this doctrine is that one may not practice fraud on a patent." *Id.*; *see also* *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1325 (Fed. Cir. 1991).

After *Markman*, another case restated the test: "With this case, this court explicitly holds that the application of the doctrine of equivalents rests on the substantiability of the differences between the claimed and accused products or processes, assessed according to an objective standard." *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1518 (Fed. Cir. 1995). "[E]valuation of function, way, and result does not necessarily end the inquiry." *Id.*

<sup>63</sup> *See* HARMON, *supra* note 18, §§ 5.6, 6.1, 6.2 (a)(ii).

Patent infringement is essentially a tort.<sup>64</sup> Direct infringement<sup>65</sup> requires neither intent nor knowledge.<sup>66</sup> The federal courts have exclusive jurisdiction over all patent litigation, including infringement actions.<sup>67</sup> The Court of Appeals for the Federal Circuit<sup>68</sup> has exclusive jurisdiction over appeals in all patent cases.<sup>69</sup>

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<sup>64</sup> See *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1579 (Fed. Cir. 1986); see also *Carbice Corp. of Am. v. Patents Dev. Corp.*, 283 U.S. 27, 33 (1931) (stating that "[i]nfringement . . . is essentially a tort, and implies invasion of some right of the patentee").

<sup>65</sup> Patent infringement comes in three flavors: direct infringement, contributory infringement, and inducement to infringe. Direct infringement is the actual commission of one of the acts specified in 35 U.S.C. § 271(a) (*i.e.*, making, using, offering to sell, or selling any patented invention without permission). Contributory infringement involves the knowing importation of something especially made or especially adapted for use in the infringement of a patent. See 35 U.S.C. § 271(c) (1994). Inducement to infringe is the active inducement of another to infringe a patent. See 35 U.S.C. § 271(b). The liability is the same for any of these types of infringement. See *id.*; HARMON, *supra* note 18, § 6.4. Unless otherwise specified, infringement as used here generally means direct infringement.

<sup>66</sup> See HARMON, *supra* note 18, § 6.2(a)(i); see also *Texas Instruments v. International Trade Comm'n* 988 F.2d 1165, 1177 (Fed. Cir. 1993) (citing *Intel Corp. v. United States ITC*, 946 F.2d 821 (Fed. Cir. 1991)).

The question [of infringement] is one irrespective of motive. The defendant may have infringed without intending, or even knowing it; but he is not, on that account, the less of an infringer. His motives and knowledge may affect the question of damages, to swell or reduce them; but the immediate question is the simple one, has he infringed?

*Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1519 (Fed. Cir. 1995) (alteration in original) (quoting *Parker v. Hulme*, 18 F. Cas. 1138, 1143 (C.C.E.D. Pa. 1849) (No. 10,740)).

<sup>67</sup> See 28 U.S.C. § 1338(a) (1994). "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents . . . . Such jurisdiction shall be exclusive of the courts of the states in patent . . . cases." *Id.*

<sup>68</sup> The Court of Appeals for the Federal Circuit was created by the Federal Courts Improvements Act of 1982, Pub. L. No. 97-164, § 101, 96 Stat. 25 (codified at various sections of 28 U.S.C.).

<sup>69</sup> See 28 U.S.C. § 1295(a)(1) (1994). In other words, the Federal Circuit has national geographic jurisdiction for patent appeals. See *id.*

### III. THE CASE

#### A. The '054 Patent<sup>70</sup>

Markman's '054 patent was for an inventory tracking system for dry-cleaning stores. Claims 1<sup>71</sup> and 10<sup>72</sup> were allegedly infringed. Because claim 10 was dependent upon claim 1, a device that did not infringe claim 1 could not infringe claim 10.<sup>73</sup> Because neither the district court nor the Federal Circuit found claim 1 to be infringed, only claim 1 needs to be analyzed here.

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<sup>70</sup> See *supra* note 2.

<sup>71</sup> Claim 1 recites:

The inventory control and reporting system, comprising a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions; a data processor including memory operable to record said information and *means to maintain an inventory total*, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting space bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

The '054 patent, *supra* note 2, claim 1 (emphasis added).

<sup>72</sup> See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 972 (Fed. Cir. 1995).

<sup>73</sup> A dependent claim is one which refers to a preceding claim for part of its subject matter. See 1 ANTHONY W. DELLER, PATENT CLAIMS § 144 (2d ed. 1971). For example, let independent claim X be "a machine comprising A, B, and C." Let dependent claim Y be "the machine of claim X further comprising D." Claim Y is effectively the same as "a machine comprising A, B, C, and D." See *id.* If an allegedly infringing device does not have an

## B. *The Parties' Constructions of Claim 1*

The only disputed term in the construction of claim 1 of the '054 patent was the term "inventory."<sup>74</sup>

### 1. *Markman's Position*

Markman's position was that the term "inventory" was not limited to articles of clothing.<sup>75</sup> Markman argued that inventory could refer exclusively to cash or invoice totals.<sup>76</sup> Markman supported this view at trial with the testimony of three witnesses.<sup>77</sup>

Under Markman's construction of claim 1, Westview's DATAMARK and DATASCAN devices<sup>78</sup> literally infringed the '054 patent.<sup>79</sup> Markman

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element of the independent claim, say B, then it cannot have all of the elements of the dependent claim. For this reason, "[o]ne who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim." *Wahpeton Canvas Co., v. Frontier, Inc.*, 870 F.2d 1546, 1552 n.9 (citing *Teledyne McCormick Selph v. United States*, 558 F.2d 1000, 1004 (Ct. Cl. 1977)). The word "comprising" is a term of art used in "open" claims. *See HARMON, supra* note 18, § 5.6, at 172. An open claims can be infringed by a device that has elements in addition to those listed in the claim. For example, a claim for a device "comprising A, B, and C" can be infringed by a device that not only has A, B, and C, but also D, E, F, and any other elements. *See HILDRETH, supra* note 18, at 183-84.

<sup>74</sup> *See Markman*, 52 F.3d at 974.

<sup>75</sup> *See id.*

<sup>76</sup> *See id.*

<sup>77</sup> *See id.* at 973. Markman called an expert on bar-code technology (which is used by the patented invention), himself as the inventor, and a "patent expert" (a practicing patent attorney). *See id.* at 980. This type of testimony is "extrinsic evidence" for claim construction. *See supra* note 61 and accompanying text.

<sup>78</sup> Westview's DATAMARK and DATASCAN devices, like the device patented in the '054 patent, are used in drycleaning stores. The DATAMARK is a stationary unit used to print bar codes about customers, the clothes they need cleaned, and the charges for the cleaning. The DATAMARK retains an invoice list consisting of the invoice numbers, dates, and cash totals (but not the types of articles of clothing) in memory. *See Markman*, 52 F.3d at 972-73.

The DATASCAN is a portable unit. After the invoice list from the DATAMARK is transferred to the DATASCAN, the DATASCAN is carried about to read the bar codes for the articles of clothing. The DATASCAN compares the bar codes to the invoice list and identifies discrepancies. *See id.*

<sup>79</sup> *See Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1536-37 (E.D. Pa. 1991).

contended that each and every limitation disclosed in claim 1 was present in Westview's devices.<sup>80</sup>

## 2. *Westview's Position*

Westview's position was that inventory meant "articles of clothing."<sup>81</sup> Westview argued that the plain language of the claim, the specification, and the prosecution history all indicated that inventory could not mean just cash or invoice totals.<sup>82</sup>

Under Westview's construction of the '054 patent, the DATAMARK and DATASCAN devices did not infringe the patent.<sup>83</sup> Westview's devices lacked a limitation recited in claim 1, namely the "means to maintain an inventory total."<sup>84</sup> Because Westview's devices lacked an essential part of the claimed invention, the devices could not infringe literally.<sup>85</sup> Moreover, because Westview's devices could not track articles of clothing, Westview's devices did not operate in substantially the same way as the '054 patent's device.<sup>86</sup> Therefore, Westview's devices did not infringe the '054 patent under the doctrine of equivalents.<sup>87</sup>

## C. *The Rulings*

### 1. *District Court*

In the trial, Westview moved for a directed verdict at the conclusion of Markman's case in chief.<sup>88</sup> The judge deferred the motion until after the trial.<sup>89</sup> The jury found in Markman's favor,<sup>90</sup> ruling that inventory could simply be

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<sup>80</sup> *See id.*

<sup>81</sup> *See Markman*, 52 F.3d at 974.

<sup>82</sup> *See id.*

<sup>83</sup> *See id.*

<sup>84</sup> *See id.* at 973-74.

<sup>85</sup> *See supra* note 62 and accompanying text.

<sup>86</sup> *See Markman*, 52 F.3d at 975 n.4. Markman's device detects spurious additions and deletions for inventory by tracking articles of clothing. *See Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1537 (E.D. Pa. 1991).

<sup>87</sup> *See supra* note 62 and accompanying text.

<sup>88</sup> *See Markman*, 772 F. Supp. at 1536. "Directed verdict" has since been renamed "judgment as a matter of law." *See* FED. R. CIV. P. 50. It is referred to throughout the appellate decision by the latter term. *See Markman*, 52 F.3d at 973 n.2.

<sup>89</sup> *See Markman*, 52 F.3d at 973.

<sup>90</sup> *See id.*

cash or invoice totals. Therefore, the jury ruled that Westview's devices infringed claims 1 and 10 of the '054 patent.<sup>91</sup>

After the jury reached its verdict, the district court judge ruled on the deferred motion.<sup>92</sup> First, the judge ruled that the first part of infringement analysis, construing the claims,<sup>93</sup> is a question of law solely for the court.<sup>94</sup> The judge then ruled that, as a matter of law, inventory meant articles of clothing and not simply cash or invoice totals.<sup>95</sup> Accordingly, the judge set aside the jury's verdict and ruled that Westview's devices did not infringe the '054 patent.<sup>96</sup>

## 2. Court of Appeals for the Federal Circuit

The following analysis of the Federal Circuit's ruling is fairly detailed. This level of detail may at first seem inappropriate in light of the fact that the Supreme Court has spoken on the matter.<sup>97</sup> However, in the case of patent law, Federal Circuit opinions have traditionally carried inordinate weight. This is partly because Federal Circuit rulings have nationwide effect.<sup>98</sup> In addition, while the Federal Circuit has "interpreted" certain Supreme Court decisions so as to effectively negate them,<sup>99</sup> the Supreme Court has only rarely reversed the Federal Circuit in the area of substantive patent law.<sup>100</sup>

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<sup>91</sup> See *id.*

<sup>92</sup> See *id.*; *Markman*, 772 F. Supp. at 1536.

<sup>93</sup> See *supra* notes 58–61 and accompanying text.

<sup>94</sup> See *Markman*, 52 F.3d at 973; *Markman*, 772 F. Supp. at 1536. The various justifications for this ruling form the heart of this Case Comment. See *infra* Parts V, VI, and VII. This ruling means that the interpretation of the meanings of terms used in the claims (the "claim language") is also a matter of law solely for the court. See *id.*

<sup>95</sup> See *Markman*, 52 F.3d at 973; *Markman*, 772 F. Supp. at 1537.

<sup>96</sup> See *Markman*, 52 F.3d at 973; *Markman*, 772 F. Supp. at 1536.

<sup>97</sup> See *infra* Part III.C.3.

<sup>98</sup> See *supra* note 5.

<sup>99</sup> See, e.g., Joel R. Bennett, *Patent Misuse: Must an Alleged Infringer Prove an Antitrust Violation?*, 17 AIPLA Q.J. 1, 12 (stating that the Federal Circuit in *Windsurfing, Int'l Inc. v. AMF, Inc.*, 828 F.2d 755 (1987), "ignored clear Supreme Court precedent"); Edmund J. Sease, *The Federal Circuit's Short Circuit of Validity Challenges: Or, Is the Spirit of Lear Dead?*, 38 DRAKE L. REV. 229, 238 (1988–89) (stating that "the Federal Circuit . . . ignored the expressed public policy of *Lear v. Adkins*[, 395 U.S. 653 (1969)]", though it was reiterated by the Supreme Court in [two subsequent cases]"); Frank S. Molinaro, Note, *Pennwalt Corp. v. Durand-Wayland, Inc.—The Federal Circuit Redefines the Doctrine of Equivalents*, 38 DEPAUL L. REV. 787, 789 (1989) (stating that the Federal Circuit in

The Federal Circuit affirmed the holding of the district court.<sup>101</sup> The first issue for the Federal Circuit was what standard to apply for reviewing the district court's ruling.<sup>102</sup> If the interpretation of claim language was an issue of fact, then the jury's verdict required significant deference.<sup>103</sup> In that case, the district court's judgment as a matter of law could stand only if no "substantial evidence . . . support[ed] a finding in favor of the nonmovant."<sup>104</sup> If the interpretation of claim language was an issue of law for the court, then the Federal Circuit would have had to examine the district court's judgment de novo.<sup>105</sup> The jury's determination would receive little deference.

The majority ruled that the interpretation of claim language is a matter of law solely for the court.<sup>106</sup> First, the majority reviewed the precedent in this

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*Pennwalt*, 833 F.2d 931 (1987), "in essence overrule[d] a United States Supreme Court precedent").

<sup>100</sup> To the author's knowledge, the only time that the Supreme Court has overruled the Federal Circuit on a substantive patent law issue was when the patentability of algorithms was at issue. See Margaret Chon, *Postmodern "Progress": Reconsidering the Copyright and Patent Power*, 43 DEPAUL L. REV. 97, 106 n.39 (1993) (observing that "the Supreme Court consistently reversed the Court of Appeals for the Federal Circuit . . . on the issue of patentability of algorithms."). Note that even this line of reversals eventually ended. See *Diamond v. Diehr*, 450 U.S. 175 (1981).

The Supreme Court has shown a greater propensity to overrule the Federal Circuit when matters other than substantive patent law are at issue. See, e.g., *Asgrow Seed Co. v. Winterboer*, 115 S. Ct. 788 (1995) (dealing with the Plant Variety Protection Act); *Cardinal Chem. Co. v. Morton Int'l Inc.*, 508 U.S. 83 (1993) (holding that affirmation by the Federal Circuit of noninfringement is not per se sufficient reason for vacating a declaratory judgment of patent invalidity, which had been the Federal Circuit's practice); *Panduit Corp. v. Dennison Mfg. Co.*, 475 U.S. 809 (1986) (holding that the Federal Circuit failed to comply with Federal Rule of Civil Procedure 52(a)); *Kaiser Aluminum & Chem. Corp. v. Bonjorno*, 494 U.S. 827 (1990) (concerning interest on damages); *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800 (1988) (concerning jurisdiction); *United States v. Hohri*, 482 U.S. 64 (1987) (same).

<sup>101</sup> See *Markman*, 52 F.3d at 968.

<sup>102</sup> See *id.* at 975.

<sup>103</sup> See *id.* (citing *Read Corp. v. Protec, Inc.*, 970 F.2d 816, 821 (Fed. Cir. 1992)).

<sup>104</sup> *Id.* at 975 (citing *Read Corp.* 970 F.2d at 821); see also *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1579 (Fed. Cir. 1986); cf. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

<sup>105</sup> See *Markman*, 52 F.3d at 975 (citing *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 501 (1984); *Bradley v. Secretary of Dep't of Health & Human Servs.*, 991 F.2d 1570, 1574 n.3 (Fed. Cir. 1993); *Heisig v. United States*, 719 F.2d 1153, 1158 (Fed. Cir. 1983)).

<sup>106</sup> See *Markman*, 52 F.3d at 979.

area.<sup>107</sup> After noting that the Federal Circuit's own precedent was split,<sup>108</sup> the majority found that the Supreme Court's precedent supported interpretation of claim language as a matter of law.<sup>109</sup> Next, the majority noted that "[i]t has long been and continues to be a fundamental principle of American law that 'the construction of a written evidence is exclusively with the court.'"<sup>110</sup> The majority stated that, because a "patent is a fully integrated written instrument,"<sup>111</sup> it is "uniquely suited for having its meaning and scope determined entirely by a court as a matter of law."<sup>112</sup>

The majority reviewed the concurrences and the dissent and found that the Seventh Amendment did not mandate any role for juries in the interpretation of claim language.<sup>113</sup> The majority discussed an analogy made in both Judge Mayer's concurrence and Judge Newman's dissent. This analogy was between interpreting claim language and construing and interpreting contracts, deeds, and wills.<sup>114</sup> The majority found this analogy wanting.<sup>115</sup> Instead, the majority analogized the interpretation of claim language to the interpretation of terms in statutory construction, reasoning that patents are more like statutes than contracts.<sup>116</sup> Whereas contracts require the consent of the parties and are

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<sup>107</sup> See *id.* at 976-79; see *infra* Part V.

<sup>108</sup> See *Markman*, 52 F.3d at 976-77.

<sup>109</sup> See *id.* at 977.

<sup>110</sup> *Id.* at 978 (quoting *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805) and citing *Eddy v. Prudence Bonds Corp.*, 165 F.2d 157, 163 (2d Cir. 1947) ("[A]ppellate courts have untrammelled power to interpret written documents")); see also 4 SAMUEL WILLISTON, WILLISTON ON CONTRACTS § 601, at 303 (3d ed. 1961).

<sup>111</sup> *Markman*, 52 F.3d at 978.

<sup>112</sup> *Id.* (citing *Bates v. Coe*, 98 U.S. 31, 38 (1878)).

<sup>113</sup> See *id.* at 984.

<sup>114</sup> See *id.*

<sup>115</sup> See *id.* at 985-87. The majority stated:

The analogy of a patent to a contract is not useful . . . in the context of a patent infringement suit. Patents are not contracts per se and patent infringement actions have never been viewed as breach of contract actions. . . . The [alleged infringer] is never a party to the so-called "contract" between the government and the inventor [for the patent].

*Id.* at 985 (citing *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877)).

<sup>116</sup> See *id.* at 987. The author contends that the analogy between patents and statutes provides the key to analyzing the constitutional issues involved in deciding if a jury must interpret claim language in patent infringement suits. However, the author believes that the Federal Circuit did not adequately recognize the flaws in this analogy and, therefore, failed to



executory in nature (both parties must do something), patents do not require the consent of an infringer and are not executory in nature.<sup>117</sup> The majority also stated:

[B]ecause both . . . [statutes and patents] may create liability in third persons who were not participants in the legislative process or the PTO proceedings, as the case may be, we conclude that the statutory interpretation model is a more accurate model than the contractual one for purposes of determining whether constitutional protections are transgressed by assigning claim construction exclusively to judges.<sup>118</sup>

The court noted that a judge could still turn to extrinsic evidence when interpreting claim language.<sup>119</sup> However, a judge would not be using the extrinsic evidence to resolve an ambiguity in the claim language. Such ambiguities, if truly present, would render the claim invalid.<sup>120</sup> Instead, the extrinsic evidence would be used “to inform the court about the language [(i.e., the technical terminology and jargon)] in which the patent [claim] is written.”<sup>121</sup>

After determining that the meaning of claim language was a matter of law solely for the court, the majority construed the claim *de novo*.<sup>122</sup> The majority reached the same conclusion as the district court judge.<sup>123</sup> The term inventory, in light of the plain language of the specification (including the claims) and the prosecution history, clearly meant article of clothing.<sup>124</sup> Therefore, Westview’s devices, which did not keep track of the articles of clothing, did not infringe.<sup>125</sup>

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realize that factual situations can arise where the jury should settle issues that can be involved in claim language interpretation. *See infra* Part VIII.B.

<sup>117</sup> *See Markman*, 52 F.3d at 985–87.

<sup>118</sup> *Id.* at 987.

<sup>119</sup> *See id.* at 986.

<sup>120</sup> *See id.*; *see also* 35 U.S.C. § 112 (1994); *supra* note 35 and accompanying text.

<sup>121</sup> *Markman*, 52 F.3d at 986.

<sup>122</sup> *See id.* at 988.

<sup>123</sup> *See id.* at 982, 988–89; *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1537 (E.D. Pa. 1991); *see also supra* notes 92–96 and accompanying text.

<sup>124</sup> *See Markman*, 52 F.3d at 982.

<sup>125</sup> *See id.* at 988–89.

In a concurrence, Judge Mayer argued that the majority “jettison[ed] more than two hundred years of jurisprudence and eviscerate[d] the role of the jury preserved by the Seventh Amendment of the Constitution of the United States.” *Id.* at 989 (Mayer, J., concurring). He stated: “Contrary to what it says today, this court (including the judges in the majority) has always held that claim interpretation is a matter of law depending on underlying factual inquiries.” *Id.* (Mayer, J., concurring). Judge Mayer went on to state that “sometimes

In a thorough dissent, Judge Newman stated that the majority's ruling "creates a litigation system that is unique to patent cases, unworkable, and ultimately unjust."<sup>126</sup> Judge Newman argued that the majority was usurping the jury's role in patent suits, using the "classification power"<sup>127</sup> of appellate courts to turn issues of fact into matters of law.<sup>128</sup> Judge Newman also put forth an in-depth discussion of the Seventh Amendment, finding that the Constitution required a jury to settle underlying factual issues in claim construction.<sup>129</sup> Finally, Judge Newman argued that the precedent supported jury determination of underlying factual issues.<sup>130</sup> Judge Newman would have remanded the case back to the district court to determine "whether there was substantial credible evidence of such quality and weight that a reasonable jury could have reached the verdict that was reached by [the district court's] jury."<sup>131</sup>

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extrinsic evidence results in a genuine dispute over the meaning of a term or an event during prosecution. When this happens, it falls to the finder of fact to settle it." *Id.* at 991 (Mayer, J., concurring) (footnote omitted). He proceeded to argue that the Seventh Amendment guaranteed this role for the jury. *See id.* at 992-93 (Mayer, J., concurring). To the extent that disputes regarding what happened during prosecution should remain the purview of the jury in the absence of an adequate written record, this Case Comment agrees with Judge Mayer's opinion. *See infra* notes 257-58 and accompanying text.

In another concurrence, Judge Rader stated that the "court need not [have] decide[d] whether subsidiary fact issues may sometimes arise" in claim construction in order to have decided the case. *Markman*, 52 F.3d at 998 (Rader, J., concurring). Judge Rader went on to state that the "court's extensive examination of subsidiary fact issues [was] dicta." *Id.* (Rader, J., concurring). He argued that no substantial evidence supported the jury's finding in the district court. *See id.* (Rader, J., concurring). Therefore, the district court judge was correct in granting judgment as a matter of law that Westview did not infringe. *See id.* at 998-99 (Rader, J., concurring).

<sup>126</sup> *Id.* at 999 (Newman, J., dissenting).

<sup>127</sup> Judge Newman stated: "Commentators have remarked on the temptation of appellate courts to redefine questions of fact as questions of law in order to impose the court's policy viewpoint on the decision." *Id.* at 1008 (Newman, J., dissenting) (citing Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993, 1018 (1986)).

<sup>128</sup> *See id.* at 1008-10 (Newman, J., dissenting).

<sup>129</sup> *See id.* at 1010-17 (Newman, J., dissenting).

<sup>130</sup> *See id.* at 1017-25 (Newman, J., dissenting).

<sup>131</sup> *Id.* at 1026 (Newman, J., dissenting).

### 3. *United States Supreme Court*

The Supreme Court unanimously affirmed the Federal Circuit's ruling.<sup>132</sup> The Court stated that "there is no dispute that [patent] infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago."<sup>133</sup> The Court went on to state that the real question was "whether a particular issue occurring within a jury trial (here the construction of a patent claim) is itself necessarily a jury issue, the guarantee [of having a jury decide that issue] being essential to preserve the right to a jury's resolution of the ultimate dispute."<sup>134</sup>

In order to answer the question, the Court first looked at historical practice and precedent.<sup>135</sup> After determining that history and precedent offered no clear answers, the Court looked to functional considerations.<sup>136</sup> The Court noted that "[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis."<sup>137</sup> Finally, the Court stated that it saw "the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of [claim] construction to the Court."<sup>138</sup> Interestingly, the Court did not pursue the analogies between patents, contracts, and statutes made by the Federal Circuit.<sup>139</sup>

## IV. RAMIFICATIONS

### A. *Claim Language Interpreted by Judges*

Under *Markman*, patent claim language is interpreted by judges.<sup>140</sup> Patent claims can contain some of the most obtuse and difficult to understand language

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<sup>132</sup> See *Markman*, 116 S. Ct. 1384, 1387 (1996).

<sup>133</sup> *Id.* at 1389.

<sup>134</sup> *Id.*

<sup>135</sup> See *id.* at 1390–95.

<sup>136</sup> See *id.* at 1395.

<sup>137</sup> *Id.*

<sup>138</sup> *Id.* at 1396. This "uniform treatment" has to do with the precedential value of claim language construction once a claim has been interpreted by the Federal Circuit. See *infra* Part IV.C.

<sup>139</sup> As mentioned *supra* note 116, the author believes that understanding these analogies is the key to making a proper determination of what issues should remain for the jury. See *infra* Part VIII.

<sup>140</sup> See *supra* note 106 and accompanying text. Under *Markman*, the interpretation of claim language is a matter of law solely for the court. See *Markman*, 116 S. Ct. at 1387.

found anywhere in the law.<sup>141</sup> Judges, who have experience in analyzing complex contracts and statutes, should have an advantage over juries in analyzing this language.<sup>142</sup> This ramification has been suggested as a reason in and of itself for excluding juries from patent suits.<sup>143</sup> The debate about such "complexity exceptions" to the Seventh Amendment right to a jury trial started well before the Federal Circuit's decision in *Markman*.<sup>144</sup> The Federal Circuit, however, has explicitly stated that it will not create a complexity exception to the Seventh Amendment.<sup>145</sup>

### B. Impact on Litigators

Because a judge interprets claim language under *Markman*, patent litigators must tailor their cases accordingly. For example, jury instructions should no longer inform a jury about how to determine the meanings of terms used in claims. Instead, jury instructions should set forth the court's interpretations of

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Questions of law are, of course, decided by judges. See *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 176 (1803).

<sup>141</sup> See HARMON, *supra* note 18, § 1.1(b), at 7. "[I]t has been well said that the claims of a patent constitute one of the most difficult legal instruments to draw." *Id.* (citing *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855 (Fed. Cir. 1988); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113 (Fed. Cir. 1987)).

<sup>142</sup> Some empirical research suggests that this argument may not be valid. See Stephen B. Judlowe & Lee A. Goldberg, *Jury Trials*, in *PATENT LITIGATION* 1994, at 173 (PLI Pat., Copyrights, Trademarks, and Literary Prop. Course Handbook Series No. 397, 1994). "In a recent three year study by the American Bar Association's Section on Litigation, it was concluded that juries in complex cases, including those involving high technology, reached verdicts consistent with the trial judge's own opinion of the evidence." *Id.*; see also *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1128 n.7 (Fed. Cir. 1985) (arguing that any judge would have a hard time matching the combined intelligence and experience of a diverse jury).

<sup>143</sup> See Judlowe & Goldberg, *supra* note 142, at 173.

<sup>144</sup> See, e.g., *Abolition of Jury Trials in Patent Cases*, 34 IDEA 77 (1994); Steven W. Davis, *Clash Between Due Process and the Right to Trial by Jury in Complex Litigation*, 35 U. MIAMI L. REV. 164 (1980); Douglas King, *Complex Civil Litigation and the Seventh Amendment Right to a Jury Trial*, 51 U. CHI. L. REV. 581 (1984).

<sup>145</sup> See *SRI*, 775 F.2d at 1130. In his concurrence, Judge Mayer argued that the *Markman* decision threatens to do just that. See *Markman*, 52 F.3d at 993 (Mayer, J., concurring). The only circuit to recognize a complexity exception is the Third Circuit. See *In re Japanese Elec. Prods. Antitrust Litig.*, 631 F.2d 1069, 1086 (3d Cir. 1980). In addition to the Federal Circuit, other circuits have explicitly rejected a complexity exception. See, e.g., *In re United States Fin. Sec. Litig.*, 609 F.2d 411, 431 (9th Cir. 1979).

the terms (and of the overall claims).<sup>146</sup> Litigators also have to re-evaluate how they utilize expert witnesses. Before *Markman*, an expert would offer an opinion as to infringement or the meaning of the claim language, and the jury would weigh the expert's testimony against other evidence.<sup>147</sup> Under *Markman*, the court can consider expert testimony.<sup>148</sup> However, the court need not hear expert testimony,<sup>149</sup> and the expert is "entitled to no deference."<sup>150</sup>

Procedurally, motions for summary judgment may become more common, especially when cases turn on claim construction.<sup>151</sup> In addition, the prudent litigator should view "discovery motions, status reports, motions in limine and proposed jury charges [as integral parts of] an overall program to educate the court."<sup>152</sup> In order to allow the parties to educate the district court judge, the actual procedure of an infringement suit may change. A preliminary hearing

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<sup>146</sup> See Mark A. Flagel et al., *An Assortment of Jury Instructions for Patent Cases*, in TRIAL OF A PATENT CASE 155, 163–66 (ALI-ABA Course of Study Series No. CA42, 1995).

<sup>147</sup> See William F. Lee & Wayne L. Stoner, *The Role of Expert Witnesses on Liability Issues in Patent Litigation in Light of Markman v. Westview Instruments*, in PATENT LITIGATION 1995, at 647 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 423, 1995).

<sup>148</sup> See *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1394–95 (1996) (quoting 2 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 732, at 481–83 (1890)) [hereinafter ROBINSON, LAW OF PATENTS]. The Federal Circuit perhaps states the rule best: "The court may, in its discretion, receive extrinsic evidence in order 'to aid the court in coming to a correct conclusion' as to the 'true meaning of the language employed' in the patent." *Markman*, 52 F.3d at 980 (citing *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 546 (1871)). Extrinsic evidence includes expert testimony. See *id.*

<sup>149</sup> Note the phrasing of the Court: "The court *may*, in its *discretion* receive extrinsic evidence. . . ." *Markman*, 52 F.3d at 980 (emphasis added).

<sup>150</sup> See *id.* at 983. Because claim construction is a question of law, an expert's opinion as to claim construction is a legal opinion that the court is free to ignore. The court held that "as to these types of opinions, the court has complete discretion to adopt the expert legal opinion as its own, to find guidance from it, or to ignore it entirely, or even to exclude it." *Id.* Stated differently, "in the actual interpretation of the patent the court proceeds upon its own responsibility." *Markman*, 116 S. Ct. at 1395 (quoting 2 ROBINSON, LAW OF PATENTS, *supra* note 148, § 732, at 481–83 (1890)).

<sup>151</sup> See Brian Michael Martin, *Federal Circuit Limits Jury's Role in Patent Trials*, 77 J. PAT. & TRADEMARK OFF. SOC'Y 641, 648 (1995). This will be especially true in cases where the claim language has already been interpreted by the Federal Circuit in a prior suit. The Federal Circuit's interpretation would be binding precedent for the district court, in effect mandating how the district court should rule. See also *infra* Part IV.C.

<sup>152</sup> Martin, *supra* note 151, at 648.

that allows the judge to interpret claim language and construe claims up front may become commonplace.<sup>153</sup>

### *C. Precedential Value of Claim Language Interpretation*

Because the Federal Circuit hears all patent appeals,<sup>154</sup> the Federal Circuit's interpretation of claim language becomes binding precedent for all district courts across the nation. As a result, a claim that has been construed on appeal has a uniform and fixed meaning in any subsequent infringement action anywhere in the United States.<sup>155</sup> The patent holder knows what he holds, and the rest of the world (or at least the nation) knows what they can or can not make, use, or sell without the patent holder's permission. This knowledge should allow for predictability and stability in the technological market place,<sup>156</sup>

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<sup>153</sup> See, e.g., *ELF Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.*, 894 F. Supp. 844, 850 (D. Del. 1995). In *ELF*, the judge held a bench trial at the start of a patent infringement suit in order to determine the meaning of disputed claim language. See *id.* Judge McKelvie scheduled two days for the hearing, which he called a "*Markman* Trial." See *id.* Such hearings may become as common for patent infringement suits as preliminary hearings are in suits where the admissibility of scientific evidence is in question. See, e.g., *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579 (1993).

<sup>154</sup> See *supra* note 5.

<sup>155</sup> Because of its national jurisdiction, the Federal Circuit's holdings have a similar impact on district court cases as the Supreme Court's holdings did before the Federal Circuit was established. In respect to the Supreme Court, Professor Robinson observed:

To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of false interpretation, from the consequences of which he could not escape. . . . [W]hen his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.

2 ROBINSON, *LAW OF PATENTS*, *supra* note 148, § 733, at 483-84 (1890), cited in *Markman*, 52 F.3d at 979.

<sup>156</sup> Contrast this situation with the one where claim language interpretation is an issue of fact. In that case, two juries for two different infringement actions could interpret the same claim language in two different ways, leading to inconsistent or even contradictory claim constructions. In addition, barring issue preclusion, a patent holder would be forced to completely relitigate the interpretation of the claim language for each and every infringement action for a patent.

thereby promoting science and the useful arts. In other words, one impact of the *Markman* ruling is the furtherance of the constitutionally mandated goal of the entire patent system.<sup>157</sup>

#### D. *Standard of Review on Appeal*

As demonstrated by this case, the standard of review on appeal for a district court's claim language interpretation is de novo.<sup>158</sup> Arguably, this de novo review perverts the roles of the trial and appellate courts, rendering the trial moot.<sup>159</sup> Resources permitting, whichever side loses at the district court level will appeal to the Federal Circuit for a fresh chance to get the claim language interpreted their way. Note, however, that such a situation is not really anything new. The same scenario occurs whenever a district court construes a fully integrated contract or a statute as a matter of law. The losing side always has the opportunity to get the interpretation of the language of the integrated contract or statute reviewed de novo, as these issues are also matters of law solely for the courts.<sup>160</sup> In addition, numerous issues in infringement cases relating to both liability and damages remain for juries under the *Markman* ruling.

#### E. *Remaining Factual Issues*

Many issues in a patent infringement suit remain within the purview of the jury after *Markman*. A few are listed here. This discussion is by no means all-inclusive; the discussion is only meant to show that substantial issues do remain for the jury.

First and foremost, the determination of whether the accused device infringes the properly construed claims remains for the jury.<sup>161</sup> This

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<sup>157</sup> See *supra* Part II.B.

<sup>158</sup> See *supra* note 122 and accompanying text.

<sup>159</sup> In fact, Judge Mayer argued that the majority's ruling upsets the role of the trial as "the 'main event' . . . rather than a 'tryout on the road.'" *Markman*, 52 F.3d at 991-92 (Mayer, J., concurring) (citing *Anderson v. City of Bessemer City*, 470 U.S. 564, 575 (1985)). In her dissent, Judge Newman repeatedly emphasizes her opinion that the majority's ruling upsets the proper roles of trial and appellate courts. See *Markman*, 52 F.3d at 999, 1008-09, 1025-26 (Newman, J., dissenting).

<sup>160</sup> See, e.g., *William & James Brown & Co. v. McGran*, 39 U.S. (14 Pet.) 479, 493 (1840); *Interwest Constr. v. Brown*, 29 F.3d 611, 614 (Fed. Cir. 1994).

<sup>161</sup> See *Markman*, 52 F.3d at 984; see also *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 758 (Fed. Cir. 1984).

determination is the second key step in infringement analysis.<sup>162</sup> In some cases, this is a simple determination involving no genuine issue of fact, and the district court can rule on the issue as a matter of law.<sup>163</sup> However, depending on the precision of the district court judge's claim construction and on the precision of the description of the allegedly infringing device, a genuine issue of fact may still remain as to whether the device actually infringes the properly construed claims.<sup>164</sup> A finding of infringement under the doctrine of equivalents<sup>165</sup> is also a factual determination.<sup>166</sup>

Alleged infringers often assert that the patent at issue is invalid. The jury may have to resolve numerous factual issues in this context.<sup>167</sup> In addition, after a finding of validity and a subsequent finding of infringement, the jury may have to determine whether the infringement was willful.<sup>168</sup> The determination of willfulness is important because willful infringement can lead to treble damages and the award of attorneys' fees.<sup>169</sup> Finally, the determination of the amount of damages is an issue for the jury.<sup>170</sup>

## V. PRECEDENT

An overview of the relevant precedent is in order. In the following discussion, only the precedent from the Supreme Court and the Federal Circuit

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<sup>162</sup> See *supra* notes 57–62 and accompanying text.

<sup>163</sup> See *Markman*, 52 F.3d at 988–89; *Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527, 530 (Fed. Cir. 1995).

<sup>164</sup> This principle is illustrated in *Johns Hopkins University v. Cellpro*, 894 F. Supp. 819 (D. Del. 1995).

<sup>165</sup> See *supra* note 62.

<sup>166</sup> See *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 936 (Fed. Cir. 1987).

<sup>167</sup> A patent can be invalidated if the invention is anticipated by the prior art. See *supra* notes 37–40 and accompanying text. Anticipation is an issue for the jury. See *Continental Can Co. USA, v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). In addition, inequitable conduct during prosecution before the Patent and Trademark Office can invalidate a patent. See *Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co.*, 324 U.S. 806, 816 (1945). The intent of the party that prosecuted the patent is central to a finding of inequitable conduct and is an issue for the jury. See *Paragon Podiatry Lab., Inc. v. KLM Lab., Inc.*, 984 F.2d 1182, 1189–90 (Fed. Cir. 1993).

<sup>168</sup> See *Graco, Inc. v. Binks Mfg. Co.*, 60 F.3d 785, 791–92 (Fed. Cir. 1995).

<sup>169</sup> See 35 U.S.C. §§ 284–85 (1994); *King Instruments Corp. v. Perego*, 65 F.3d 941, 947 (Fed. Cir. 1995).

<sup>170</sup> See *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 926 F.2d 1161, 1164 (Fed. Cir. 1991).



is discussed.<sup>171</sup> As is often the case when dealing with important issues, precedent by itself is not dispositive.

### A. *United States Supreme Court*

One of the more instructive Supreme Court cases to directly address the law versus fact aspects of patent infringement is *Winans v. Denmead*.<sup>172</sup> In that case, the court stated:

Still the question must always be, whether, whatever the shape he [(the alleged infringer)] adopts, he is not availing himself of the principle first suggested by the patentee; a question which, in a court of law, is at all times a question not for the court, but the jury; *after the former* [(the court)] *shall have given to the specification that construction which is to govern the latter* [(the jury)] in determining whether the infringement complained of falls, substantially, in principle and mode of operation, within the plaintiff's patent.<sup>173</sup>

Winans's invention was a rail car for the transportation of coal.<sup>174</sup> The rail car was in the form of "a frustrum of a [circular] cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions."<sup>175</sup> The allegedly infringing rail car was in the shape of an octagonal pyramid.<sup>176</sup>

At first blush, this case seems to support the proposition that claim construction is a question of law solely for the court. However, *Winans* was decided in 1853, well before claims were required in patents.<sup>177</sup> Therefore, saying that *Winans* stands for any proposition concerning claim construction is

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<sup>171</sup> Precedent from the various circuit courts of appeals from before the establishment of the Federal Circuit is not reviewed. As will become apparent, the precedent from the Supreme Court is sufficiently lacking and the precedent from the Federal Circuit is sufficiently muddled to necessitate a deeper analysis of the policies and theories behind the *Markman* ruling. See *infra* Parts V.A and V.B. Suffice it to say that bringing in all of the various circuit courts would just muddy the waters further, to no avail.

<sup>172</sup> 56 U.S. (15 How.) 330 (1853).

<sup>173</sup> *Id.* at 336 (emphasis added).

<sup>174</sup> See *id.* at 331.

<sup>175</sup> *Id.*

<sup>176</sup> See *id.* at 332.

<sup>177</sup> See Patent Act of 1870, ch. 230, § 26, 16 Stat. 198, 201 (repealed 1952); *supra* note 35 and accompanying text.

inaccurate. However, the specification for the patent at issue did include language very similar to a claim.<sup>178</sup>

In addition, whether or not the Court in *Winans* actually defined the key language in the patent is open to argument. The Court in *Winans* concluded with a statement that a rail car, in order to infringe, "must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention."<sup>179</sup> The Court refused to state whether or not the allegedly infringing octagonal design met this test, leaving that question for the jury.<sup>180</sup> Arguably, the Court was construing the language of the patent and leaving the comparison to the octagonal rail car to the jury.<sup>181</sup> However, as Judge Mayer stated in his *Markman* concurrence, the Court in *Winans* may have been construing the language of the patent "in a general manner," leaving it to the jury to "fill in the specifics."<sup>182</sup>

One other Supreme Court case, *Bischoff v. Wethered*,<sup>183</sup> stands out. The Court in that case stated:

It is undoubtedly the common practice of the United States Circuit Courts, in actions at law, on questions of priority of invention, where a patent under consideration is attempted to be invalidated by a prior patent, *to take the evidence of experts as to the nature of the various mechanisms or manufactures described in the different patents* produced, and as to the identity<sup>184</sup> or diversity between them; and to *submit all the evidence to the jury under general instructions* as to the rules by which they are to consider the evidence. . . . [I]n all such cases the question [of identity] would . . . be treated as *a question of fact for the jury*, and not as a question of law for the court.<sup>185</sup>

On its face, this quote appears to be strong support for the position that claim construction involves underlying factual determinations by a jury. However, three points temper this conclusion. First, *Bischoff* was not a patent

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<sup>178</sup> See *Winans*, 56 U.S. at 331. The specification included this phrase: "What I claim as my invention, and desire to secure by letters patent is . . . ." *Id.*

<sup>179</sup> *Id.* at 344.

<sup>180</sup> See *id.*

<sup>181</sup> Framed this way, *Winans* looks a lot like *Markman*. The claim (or claim like language) is construed as a matter of law, and the comparison of the allegedly infringing device to the properly construed claim is an issue of fact. See *supra* notes 106, 140, 161, and accompanying text.

<sup>182</sup> See *Markman*, 52 F.3d at 995 (Mayer, J., concurring).

<sup>183</sup> 76 U.S. (9 Wall.) 812 (1869).

<sup>184</sup> The key issue was whether or not a patent was identical to, and thus anticipated by, another prior patent. See *id.* at 814. Note that this issue is not infringement.

<sup>185</sup> *Id.* at 814 (emphasis added) (footnote added).

infringement suit. Second, *Bischoff* was heard before passage of the Patent Act of 1870, again well before claims were required in patents.<sup>186</sup> In fact, as the Federal Circuit's majority in *Markman* noted, the word "claim" does not even appear in the *Bischoff* opinion.<sup>187</sup> Third, the Court in *Bischoff* seemed to think that hearing expert testimony (extrinsic evidence) and ruling on the interpretation of patent language as a matter of law, were mutually exclusive.<sup>188</sup> As *Markman* demonstrates, though, these two activities can co-exist.<sup>189</sup>

Both the Federal Circuit and the Supreme Court cited numerous other Supreme Court cases.<sup>190</sup> However, none of these are more enlightening than *Winans* and *Bischoff*. In conclusion, the Supreme Court simply has never stated, in the context of a modern patent infringement suit, whether the interpretation of claim language is a matter of law or an issue of fact.

### B. Court of Appeals for the Federal Circuit

The Federal Circuit's majority admitted that the court's own precedent is split.<sup>191</sup> The majority identified two main lines of cases, one holding that claim construction (and thus the interpretation of claim language) is entirely a matter of law and the other holding that claim construction "may have underlying factual inquiries that must be submitted to the jury."<sup>192</sup>

In *SSIH Equipment S.A. v. United States International Trade Commission*,<sup>193</sup> the Federal Circuit ruled that claim construction was entirely a matter of law.<sup>194</sup> No mention of any underlying factual issue is made in *SSIH*. A line of cases follows *SSIH*; none of those cases makes any mention of any

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<sup>186</sup> See *supra* note 35 and accompanying text.

<sup>187</sup> See *Markman*, 52 F.3d at 988.

<sup>188</sup> See *Bischoff*, 76 U.S. at 814-15. In justifying its ruling, the Court in *Bischoff* states: "If the courts themselves were compellable to decide on these often recondite and difficult questions, *without the aid of scientific persons* familiar with the subject of the inventions in question, they might be led into irremediable errors, which would produce great injustice to the suitors." *Id.* at 815 (emphasis added).

<sup>189</sup> See, e.g., *Markman*, 52 F.3d at 980; *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989).

<sup>190</sup> See *Markman*, 116 S. Ct. at 1390-91, 93, 94 nn.12-13; *Markman*, 52 F.3d at 977-78; *id.* at 1021-25 (Newman, J., dissenting).

<sup>191</sup> See *Markman*, 52 F.3d at 976.

<sup>192</sup> *Id.*

<sup>193</sup> 718 F.2d 365 (Fed. Cir. 1983).

<sup>194</sup> See *id.* at 376.

underlying factual issues.<sup>195</sup> Of particular note is *Specialty Composites v. Cabot Corp.*,<sup>196</sup> which states that “[i]n reviewing the interpretation of the meaning of claims, the reviewing court need not defer to the district court either under a ‘clearly erroneous’ standard or otherwise.”<sup>197</sup>

A second line of cases holds that claim construction is a question of law with underlying factual issues. This line starts with *McGill Inc. v. John Zink Co.*<sup>198</sup> *McGill* states that “[i]f . . . the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, construction of the claims could be left to a jury.”<sup>199</sup> However, in *Envirotech Corp. v. Al George, Inc.*,<sup>200</sup> 730 F.2d 753 (Fed. Cir. 1984) the court never mentioned extrinsic evidence in conjunction with claim construction.<sup>201</sup> In fact, the court in *Envirotech* expressly construed the claim<sup>202</sup> and then stated that it was up to the jury to determine whether the defendant’s apparatus infringed the claim.<sup>203</sup>

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<sup>195</sup> See, e.g., *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.*, 888 F.2d 815, 818 (Fed. Cir. 1989) (“Construction of claim scope (claim interpretation) . . . is a question of law for decision by the trial judge on motion for JNOV and by this court on appeal.”); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988) (“The claimed invention must first be defined, a legal question of claim interpretation.”); *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985); *Bandag, Inc. v. Al Bolser’s Tire Stores, Inc.*, 750 F.2d 903, 922 (Fed. Cir. 1984) (finding as a matter of law that a claimed invention was a method); *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 956 (Fed. Cir. 1983); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 770–71 (Fed. Cir. 1983). Note that not all these cases are mentioned in *Markman*.

<sup>196</sup> 845 F.2d 981 (Fed. Cir. 1988).

<sup>197</sup> *Id.* at 986 (citing *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985)).

<sup>198</sup> 736 F.2d 666 (Fed. Cir. 1984).

<sup>199</sup> *Id.* at 672 (citing *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753 (Fed. Cir. 1984). In the cases in this line, this statement is read as a command to leave such questions to the jury. For a list of these cases, see *infra* note 204.

<sup>200</sup> 730 F.2d 753 (Fed. Cir. 1984).

<sup>201</sup> See *id.* 753. The extrinsic evidence, expert testimony in this case, was instead discussed with respect to the second part of infringement analysis, comparing the accused device to the properly construed claim. See *id.* at 759–60.

<sup>202</sup> See *id.* at 759.

<sup>203</sup> See *id.* The court stated that “[t]he patented invention as indicated by the claims must first be defined (a question of law), and then the trier must judge whether the claims cover the accused advice (a question of fact).” *Id.* at 758. Note that this is the exact procedure that should have been applied under *Markman*.

Numerous cases follow *McGill's* improper reading of precedent.<sup>204</sup> Thus, one view of the "underlying factual issue" approach is that it is simply the perpetuation of a misreading of precedent.

A subset of the line of cases that find underlying factual issues actually hold a middle position. These cases state, in various terms, two propositions: (1) claim construction is a matter of law, and (2) a dispute over the meaning of a term within a claim does not *necessarily* create a genuine issue of fact.<sup>205</sup> These cases are interesting because they almost uniformly hold that judgment as a matter of law is allowed despite actual disputes over the meanings of terms in claims. The outcomes of these cases are generally the same as those from *SSIH* and its line. The claims are construed as a matter of law, with no factual issues for the jury. However, the language of these cases sounds more like that in the cases that find underlying factual issues. The implication of the language is that underlying factual issues can arise in claim construction.<sup>206</sup>

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<sup>204</sup> See, e.g., *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1364 (Fed. Cir. 1991); *Tol-O-Matic, Inc. v. Proma Produkt Und Mktg. Gesellschaft*, 945 F.2d 1546, 1550 (Fed. Cir. 1991); *Perini Am., Inc. v. Paper Converting Mach. Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *H.H. Robertson, Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986); *P.M. Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 614 (Fed. Cir. 1984). Note that not all these cases are mentioned in *Markman*.

<sup>205</sup> See, e.g., *Wolverine World Wide, Inc. v. Nike, Inc.* 38 F.3d 1192, 1196-97 (Fed. Cir. 1994); *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 545-46 (Fed. Cir. 1994); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992); *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 797 (Fed. Cir. 1990); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 643 (Fed. Cir. 1987); *George v. Honda Motor Co.*, 802 F.2d 432, 434 (Fed. Cir. 1986); *Molinaro v. Fannon/Courier Corp.*, 745 F.2d 651, 654 (Fed. Cir. 1984). The Federal Circuit did not distinguish between the cases discussed *supra* notes 198-204 and these cases. The distinction is somewhat ephemeral. The cases discussed *supra* notes 198-204 hold that disputes over claim language *are* to be settled by the jury, while the cases in this middle line hold that disputes over claim language *are not necessarily* for the jury.

<sup>206</sup> Judge Rader's concurrence in the Federal Circuit opinion fits nicely with this line of cases. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 998-99 (Fed. Cir. 1995) (Rader, J., concurring). While Judge Rader argued that *Markman* could be decided without addressing the law versus fact status of claim construction, he did state that no actual factual issue existed. See *id.* at 998 (Rader, J., concurring). He went on to state that "Markman cannot manufacture a fact issue where none exists." *Id.* (Rader, J., concurring). Thus, Rader argued that the district court's judgment as a matter of law in favor of Westview was proper despite the dispute over the meaning of the term inventory. See *id.* at 998-99 (Rader, J., concurring).

Two cases from this "middle of the road" group are particularly instructive. The first one, *Johnston v. IVAC Corp.*,<sup>207</sup> states that "a mere dispute over the meaning of a term [in a claim] does not itself create an issue of fact . . . even where the meaning cannot be determined without resort to the specification, the prosecution history or other extrinsic evidence."<sup>208</sup> This rule is only a short step away from the *Markman* ruling. In *Johnston*, the court did not find any issues of fact, despite having to look to the specification in order to construct the claims.<sup>209</sup>

The second case, *Howes v. Medical Components, Inc.*,<sup>210</sup> put forth the same pair of propositions as the rest of the middle of the road cases: "Claim construction is a question of law[,] and the mere existence of a dispute as to that legal issue does not preclude summary judgment."<sup>211</sup> However, the court found a material issue of fact in *Howes*.<sup>212</sup> The court stated that "[f]rom the record, it is impossible to tell what transpired during [an] interview [between the examiner and Howes' attorney]—apparently only the examiner and Howes' attorney were present."<sup>213</sup> The issue of what occurred during the prosecution, the key issue in the case, was left to the jury.<sup>214</sup>

*Howes* presents a difficult dilemma for a court attempting to follow the *Markman* ruling. When ruling on claim construction as a matter of law, the court bases its construction on the ordinary meaning of the language in the claims, the specification, and the prosecution history.<sup>215</sup> In a case such as *Howes*, though, the prosecution history is not known—it is the very thing in dispute. A court determining what events actually occurred in the past as a matter of law without an adequate written record would be strange. In fact, this type of issue—what to believe when people give an account of their past actions—represents the archetype of a factual issue.<sup>216</sup> However, for a court to

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<sup>207</sup> 885 F.2d 1574 (Fed. Cir. 1989).

<sup>208</sup> *Id.* at 1579.

<sup>209</sup> *See id.* at 1580.

<sup>210</sup> 814 F.2d 638 (Fed. Cir. 1987).

<sup>211</sup> *Id.* at 643.

<sup>212</sup> *See id.* at 645.

<sup>213</sup> *Id.*

<sup>214</sup> *See id.* at 646.

<sup>215</sup> The court can also consider extrinsic evidence such as expert testimony. *See supra* note 61 and accompanying text.

<sup>216</sup> The credibility of the person giving the account is not only a key factor in this type of situation, it may be the only significant factor. *See, e.g.,* *Culombe v. Connecticut*, 367 U.S. 568, 603 (1961). The general rule is "that the question of the credibility of witnesses is one for the jury alone." *Chesapeake & Ohio Ry. Co. v. Martin*, 283 U.S. 209, 216 (1931). Note that this credibility determination is conceptually different than when two experts are

construe the claims solely as a matter of law in this type of case, the court would have to rule on such a factual issue as a matter of law.

### C. Conclusion

In general, the precedent is not dispositive. Neither the Supreme Court nor the Federal Circuit has provided a clear standard for judging the *Markman* ruling as a whole. Thus, in order to make a definitive judgment about *Markman*, a deeper analysis of claim language interpretation is necessary.

## VI. THE SEVENTH AMENDMENT

Both the Supreme Court and the Federal Circuit discussed the Seventh Amendment right to a jury trial.<sup>217</sup> The Seventh Amendment states:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.<sup>218</sup>

Suits at common law include "suits in which *legal* rights [are] to be ascertained and determined, in contradistinction to those where equitable rights alone [are] recognized, and equitable remedies [are] administered."<sup>219</sup> The right to a jury trial also extends to causes of action created by Congress.<sup>220</sup>

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presenting conflicting opinions that they both believe to be true. In that situation, the judge is deciding which expert is correct, not whether the expert is mistaken about or fabricating a story concerning the occurrence of an event. As the Supreme Court stated the situation with respect to experts, "[A]ny credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document." *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1395 (1996).

<sup>217</sup> See *Markman*, 116 S. Ct. at 1389–93; *Markman*, 52 F.2d at 983–84; *id.* at 992–93 (Mayer, J., concurring); *id.* at 1010–17 (Newman, J., dissenting); see also *supra* Part III.C.2 to .3.

<sup>218</sup> U.S. CONST. amend. VII. Note that the right is preserved. In other words, the Seventh Amendment guarantees the same right to a jury trial as existed in the late eighteenth century. See *Tull v. United States*, 481 U.S. 412, 417–18 (1987).

<sup>219</sup> *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830).

<sup>220</sup> See *Tull*, 481 U.S. at 417. Patent infringement is a cause of action created by Congress. See 35 U.S.C. § 271 (1994).

The actual issue here is not whether the Seventh Amendment guarantees the right to a jury trial in patent infringement suits. Instead, the issue is whether a Seventh Amendment right to a jury interpretation of claim language exists.<sup>221</sup>

### A. *The Tests*

The determination of whether the right to a jury trial exists under the Seventh Amendment involves two tests. "First, [the court] compare[s] the statutory action to eighteenth-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, [the court] examine[s] the remedy sought and determine[s] whether it is legal or equitable in nature."<sup>222</sup> At trial, the second test is the more compelling of the two.<sup>223</sup>

#### 1. *The Historical Test*

The historical test involves comparing the issue in question to English law in the eighteenth century. In England at that time, "most patent actions were brought under the legal action of trespass on the case and were tried to juries."<sup>224</sup> Therefore, under this test, a right to a jury trial in patent infringement suits exists. However, modern mandatory patent claims, and thus modern claim language interpretation, did not exist in 1791.<sup>225</sup>

In order to determine the Seventh Amendment status of a cause of action that did not exist in eighteenth century England, the Supreme Court in *Chauffeurs, Local No. 391 v. Terry*<sup>226</sup> looked to "an analogous cause of action that existed in the eighteenth century."<sup>227</sup> Furthermore, the Court analogized a

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<sup>221</sup> See *Ross v. Bernhard*, 396 U.S. 531, 538 (1970). "The Seventh Amendment question depends on the nature of the issue to be tried rather than the character of the overall action." *Id.*

<sup>222</sup> See *Tull*, 481 U.S. at 417-18 (citations omitted).

<sup>223</sup> See *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989).

<sup>224</sup> *R. William Ide, III, et al., Hilton Davis Chemical Co. v. Warner-Jenkinson Company, Inc.*, 3 FED. CIR. B.J. 357, 383 (1993) (citing *Gould v. Rees*, 82 U.S. (15 Wall.) 187 (1872)); see also *Turrill v. Michigan S. R.R. Co.*, 68 U.S. (1 Wall.) 491 (1864); *Hausknecht v. Claypool*, 66 U.S. (1 Black) 431 (1862); *Teese v. Huntingdon*, 64 U.S. (23 How.) 2 (1860); *Chaffe v. Boston Belting Co.*, 63 U.S. (22 How.) 217 (1859); *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848).

<sup>225</sup> See *supra* note 35 and accompanying text.

<sup>226</sup> 494 U.S. 558 (1990).

<sup>227</sup> *Id.* at 565-66. In *Chauffeurs*, the Court analogized an action "for breach of a union's duty of fair representation" to an action "by a trust beneficiary against a trustee for breach of



single issue in *Chauffeurs* to an eighteenth century issue.<sup>228</sup> Thus, in order to settle the historical test, an analogy must be made between the interpretation of claim language and the proper eighteenth century English issue.

In some cases, the interpretation of claim language can be analogized to a dispute about the meaning of a term in a contract.<sup>229</sup> If the dispute is caused by a conflict in the evidence, the issue is analogous to an issue tried before a jury in the eighteenth century.<sup>230</sup> Thus, under this analogy and in cases where conflicting evidence creates a dispute in the interpretation of claim language, a right to a jury interpretation of claim language exists.

Alternatively, the interpretation of claim language can be analogized to the interpretation of language in a statute.<sup>231</sup> The interpretation of a statute, a question of law, is considered to be an issue that was for the courts in eighteenth century England.<sup>232</sup> Therefore, under this second analogy, no right

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fiduciary duty." *Id.* at 565–69. Note that collective bargaining, and thus unions, were illegal under eighteenth century English law. *See id.* at 565–66.

<sup>228</sup> The court analogized an issue under the Labor Management Relations Act of 1947, ch. 120, § 301, 61 Stat. 156 (codified at 29 U.S.C. § 185), to a breach of contract claim. *See Chauffeurs*, 494 U.S. at 569–70.

<sup>229</sup> *See infra* Part VII.A.

<sup>230</sup> *See Chauffeurs*, 494 U.S. at 569–70; *see also* *Great N. Ry. Co. v. Merchants Elevator Co.*, 259 U.S. 285, 292 (1922).

<sup>231</sup> *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 987 (Fed. Cir. 1995); *see also infra* Part VII.B. Note that the Supreme Court did not pursue these analogies in *Markman*.

<sup>232</sup> This proposition is not as clear cut as it may at first appear. In *Bushell's Case*, 6 How St. Tr. 999 (1670), an English court ruled that a jury could not be fined for refusing to follow another court's instructions, allowing the jury to disregard the other court's determination of law in the case before it. The early American courts approved of this power, called "jury nullification." For example, Chief Justice John Jay used the following jury instruction in one of the first civil cases heard under the original jurisdiction of the Supreme Court:

It may not be amiss, here, gentlemen, to remind you of the good old rule, that on questions of fact, it is the province of the jury, on questions of law, it is the province of the court, to decide. But it must be observed that by the same law, . . . you have, nevertheless, a right to take upon yourselves to judge of both, and to determine the law as well as the fact in controversy.

*Georgia v. Brailsford*, 3 U.S. (3 Dall.) 1, 4 (1794), *cited in* Noel Fidel, *Preeminently a Political Institution: The Right of Arizona Juries to Nullify the Law of Contributory Negligence*, 23 ARIZ. ST. L.J. 1, 4 (1991). However, in *Sparf & Hansen v. United States*,

to a jury interpretation of claim language exists.<sup>233</sup>

Thus, in order to make a determination under the historical test, the proper analogy must be chosen. Until an analogy is chosen, the character of the interpretation of claim language under the historical test is an open question.<sup>234</sup>

## 2. *The Remedy Test*

Legal remedies indicate a right to a jury trial; equitable remedies do not.<sup>235</sup> The remedies for patent infringement include damages<sup>236</sup> (a legal remedy) and permanent injunctions<sup>237</sup> (an equitable remedy). Where both types of remedies

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156 U.S. 51 (1895), the concept of jury nullification in the federal judiciary was rejected by the Supreme Court:

Under any other system [than one where the jury has a duty to obey the court's determination of the law], the courts, although established in order to declare the law, would for every practical purpose be eliminated from our system of government as instrumentalities devised for the protection equally of society and of individuals in their essential rights. When that occurs our government will cease to be a government of laws, and become a government of men.

*Id.* at 102-03. The Court stated that the concept of jury nullification was "founded on a confusion between the ideas of power and right." *Id.* at 88 (emphasis omitted). Note that the courts have been accused of "fierce resolution and deceptive ingenuity" in restricting jury determination of law. See Marke DeWolfe Howe, *Juries as Judges of Criminal Law*, 52 HARV. L. REV. 582, 616 (1939).

The orthodox view of eighteenth century British law agrees with the power versus right distinction: "It is probably the sound view, at common law, that this power of the jury in criminal cases [to disregard the judge's instructions] does not and did not, in any distinct and modern sense, import a right on their part to determine the law." JAMES THAYER, A PRELIMINARY TREATISE ON EVIDENCE AT THE COMMON LAW 169, 256 (1898), cited in Howe, *supra*, at 583. "[T]he traditional British proposition [is] that the jury's right to return a general verdict in criminal cases gives it only a power, and not a moral or legal right to determine the law upon their own initiative regardless of the court's instruction." *Id.* at 584.

<sup>233</sup> Note that the jury is not rendered a nonentity by removing them from claim language interpretation. Several key issues in an infringement suit (including the actual determination of infringement) remain within the purview of the jury. See *supra* Part IV.E.

<sup>234</sup> Patents are analogized to contracts and to statutes. See *infra* Part VII.

<sup>235</sup> See *Curtis v. Loether*, 415 U.S. 189, 194 (1974).

<sup>236</sup> See 35 U.S.C. § 284 (1994); see also *supra* note 55 and accompanying text.

<sup>237</sup> See 35 U.S.C. § 283 (1994); see also *supra* note 56 and accompanying text.

exist, a right to a jury trial exists.<sup>238</sup> Thus, under this part of the inquiry, a right to a jury trial in patent infringement suits exists. However, no remedy directly results from the interpretation of claim language. Therefore, this test fails to indicate whether a Seventh Amendment right to a jury interpretation of claim language exists.<sup>239</sup>

## B. Conclusion

Both the historical test and the remedy test indicate that the Seventh Amendment protects the right to a jury trial in patent infringement suits. However, the remedy test does not indicate whether a right to a jury interpretation of claim language exists. Without more analysis, the historical test is also inconclusive. The historical test can be resolved only if the proper analogy is drawn between the interpretation of claim language and an issue in eighteenth century English law.

## VII. PATENTS ANALOGIZED TO CONTRACTS AND STATUTES<sup>240</sup>

### A. Patents as Contracts

A patent can be viewed as a contract between the government and an inventor for the benefit of society.<sup>241</sup> The government gives the inventor the exclusive right to make, use, and sell his invention; in return, the inventor discloses the invention to the public,<sup>242</sup> thereby promoting the useful arts.<sup>243</sup>

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<sup>238</sup> “[I]f [a] legal claim is joined with an equitable claim, the right to jury trial on the legal claim, including all issues common to both claims, remains intact. The right cannot be abridged by characterizing the legal claim as ‘incidental’ to the equitable relief sought.” *Curtis*, 415 U.S. at 196 n.11.

<sup>239</sup> See *supra* note 221 and accompanying text.

<sup>240</sup> The Supreme Court did not pursue this line of analysis. See generally *Markman v. Westview*, 116 S. Ct. 1384, 1384 (1996). While the Federal Circuit did discuss these analogies, see *supra* notes 114–18 and accompanying text, the Federal Circuit failed to consider the full ramifications of the analysis. This resulted in a ruling that may be overbroad in some situations. See *infra* notes 248–59 and accompanying text.

<sup>241</sup> See *Marcy v. Nissen Corp.*, 578 F. Supp. 485, 498 (N.D. Ind. 1982) (citing *Krupp A.G. v. Midvale Steel Co.*, 191 F. 588 (3d Cir. 1911); *Catanzaro v. Masco Corp.*, 423 F. Supp. 415, 431 (D. Del. 1976), *aff’d*, 575 F.2d 1085 (3d Cir. 1978); *HILDRETH*, *supra* note 18, at 1.

<sup>242</sup> See *HILDRETH*, *supra* note 18, at 1.

<sup>243</sup> See *supra* Part II.A.

While the contract analogy may be valid between a patentee and the government, the analogy fails between a patentee and an alleged infringer. The alleged infringer is not a party to the issue of the patent.<sup>244</sup> No "meeting of minds" exists between the patentee and the alleged infringer.<sup>245</sup> In addition, the intent of the alleged infringer is wholly irrelevant to a finding of infringement.<sup>246</sup> Thus, an analogy between a patent and a contract is not proper in the infringement context.<sup>247</sup>

### B. *Patents as Statutes*

In many ways, patents are similar to statutes. "[B]oth of these public instruments may create liability in third persons who were not participants in the legislative process or the PTO proceedings."<sup>248</sup> In other words, both restrict otherwise lawful activities. The specification and prosecution history of a patent are somewhat analogous to the legislative history of a statute. They all are public records that can be used to help understand the corresponding instrument.<sup>249</sup> In addition, extrinsic evidence can be used to explain the language in each.<sup>250</sup> For these reasons, the analogy of a patent to a statute in patent infringement cases is appropriate. However, the analogy is not perfect.

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<sup>244</sup> See *Markman v. Westview*, 52 F.3d 967, 985 (Fed. Cir. 1995) (citing *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877)).

<sup>245</sup> "[A] contract is the concrete result of the meeting of the minds of the contracting parties." *Richmond & Allegheny R.R. Co. v. R.A. Patterson Tobacco Co.*, 169 U.S. 311, 314 (1898).

<sup>246</sup> See *supra* note 66 and accompanying text. Intent, in the form of willfulness, can affect damages. See *supra* note 170 and accompanying text.

<sup>247</sup> Even if a patent could be considered an actual contract between a patentee and an infringer, the patentee might not like the result. While this may lead to a conclusion that the Seventh Amendment guarantees a right to jury interpretation of claim language, see *supra* Part VI, another basic principle of contract law might obviate this right. This is the principle that ambiguous language in contracts should be construed against the drafter. See, e.g., *Mastrobuono v. Shearson Lehman Hutton, Inc.*, 115 S. Ct. 1212, 1219 (1995). Clearly, the patentee is the drafter, so any ambiguity in the claim language that causes a factual dispute would be construed against the patentee.

<sup>248</sup> *Markman*, 52 F.3d at 987.

<sup>249</sup> See *id.* in relation to legislative history see also *United States v. John C. Grimberg Co.*, 702 F.2d 1362, 1365, 1368 (Fed. Cir. 1983); in relation to prosecution history see *supra* note 50 and accompanying text.

<sup>250</sup> See *supra* note 61 and accompanying text (extrinsic evidence with patent infringement). A prime example of the use of extrinsic evidence in statutory construction is the referral to a dictionary to help determine the plain meaning of a word in a statute. See,

Patents and statutes are created in entirely different ways. Patents are created through a series of proceedings between an inventor and the Patent and Trademark Office.<sup>251</sup> Statutes are created through the legislative process. As a result, the character of the public records used to help understand each of these instruments differs considerably.

The specification and claims for a patent are fixed<sup>252</sup> in a similar fashion as the legislative history of a statute is fixed. However, the occurrence of events in the prosecution of a patent may be in dispute.<sup>253</sup> If such a dispute exists, the inventor, his attorney, and even the examiner<sup>254</sup> can be called to testify about

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*e.g.*, *Bailey v. United States*, 116 S. Ct. 501, 506 (1995) (determining the meaning of the word "use" for a firearms conviction). In *Bailey*, the Court may have even relied on a study by an expert. "Some linguists say that the Court in its opinion appears to have accepted a linguistic study that was submitted with a brief by the lawyers for a defendant." Hope Viner Sanborn, *Looking for the Meaning of Life? Call a Linguist*, 82 A.B.A. J., Feb. 1996, at 28, 28.

<sup>251</sup> See *supra* Part II.C.1.

<sup>252</sup> See *supra* notes 48–50 and accompanying text.

<sup>253</sup> See, *e.g.*, *Howes v. Medical Components, Inc.*, 814 F.2d 638, 645 (Fed. Cir. 1987) ("Both sides have raised questions as to the effect of prosecution history of the reissue . . . and both differ greatly in their account of what happened during that proceeding. . . . From the record, it is impossible to tell what transpired during the interview [with the examiner].").

<sup>254</sup> See *Western Electric Co. v. Piezo Tech., Inc.*, 860 F.2d 428, 431–32 (Fed. Cir. 1988).

[T]he general rule [is] that a patent examiner cannot be compelled to testify regarding his "mental processes" in reaching a decision on a patent application. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 322, 181 USPQ 329, 329 (E.D. Pa. 1974); *Monsanto Co. v. Dawson Chemical Co.*, 176 USPQ 349, 349 (E.D. Va. 1972); *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170, 170 (S.D. Tex. 1970), *later proceeding*, 175 USPQ 613, 614 (S.D. Tex. 1972); *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969). See also *American Cyanamid v. F.T.C.*, 363 F.2d 757, 778–79, 150 USPQ 135, 150–51 (6th Cir. 1966), *later proceeding*, 401 F.2d 574 (6th Cir. 1968). The courts have held, however, that patent examiners may be deposed if the questions are limited to factual matters and if the questioning does not delve into "hypothetical or speculative areas" or the examiner's "bases, reasons, mental processes, analyses or conclusions." *Shaffer Tool Works*, 167 USPQ at 171; accord *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. at 322, 181 USPQ at 329; *Standard Packing Corp. v. Curwood, Inc.*, 365 F. Supp. 134, 136, 180 USPQ 235, 256 (N.D. Ill. 1973); *Monsanto Co.*, 176 USPQ at 349; *In re Mayewsky*, 162 USPQ at 89; see also *Manual of Patent Examining Procedure* § 1701.01; Lupo, *The Impact of In re Mayewsky: What Should An Examiner Be Allowed To Testify To?*, 55 J. Pat. Off. Soc'y 216 (1973).

the disputed events. However, any gaps in the legislative history of a statute are not subject to the same kind of inquiry. For example, one side in a trial cannot call a senator to the stand and ask her about events leading to the passage of a statute.<sup>255</sup> The court is stuck with the ordinary meaning of the language in the statute<sup>256</sup> and any available legislative history.<sup>257</sup> Thus, the materials available for construing a patent can be different in nature from those available for construing a statute.

This difference is the reason why disputes regarding what happened during prosecution should remain the purview of the jury in the absence of an adequate written record.<sup>258</sup> As mentioned above, the determination of these disputes requires a credibility judgment—the archetype of a factual issue.<sup>259</sup> In addition, as the above analysis illustrates, this type of dispute also falls outside the analogy between patents and statutes. This analogy is the basis for a proper determination that claim construction is generally an issue for the court. Thus, these types of factual disputes do not properly share the question of law character of interpreting claims based on the language of the claims, the specification, and the settled prosecution history.

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*Id.*

<sup>255</sup> See U.S. CONST. art. I, § 6, cl. 1. “The Senators and Representatives . . . for any Speech or Debate in either House . . . shall not be questioned in any other Place.” *Id.* Alexander Bickel has suggested that this clause is necessary, because “[i]t is simply unthinkable that members of legislative majorities should from time to time be subject to cross-examination in various courts over the country regarding their state of mind when they voted.” ALEXANDER M. BICKEL, *THE LEAST DANGEROUS BRANCH: THE SUPREME COURT AT THE BAR OF POLITICS* 215 (1962). The issue can become clouded when other constitutional considerations are involved. See generally Louis S. Raveson, *Unmasking the Motives of Government Decisionmakers: A Subpoena for Your Thoughts?*, 63 N.C. L. REV. 879 (1985).

<sup>256</sup> See *Smith v. United States*, 508 U.S. 223, 228 (1993).

<sup>257</sup> See *Staples v. United States*, 114 S. Ct. 1793, 1797 (1994).

<sup>258</sup> While this type of dispute may be rare historically (the author could find few instances in the case history besides *Howes*, discussed *supra* notes 210–16 and accompanying text), the practice surrounding examiner interviews may be fertile ground for such disputes. As discussed *supra* note 47, the applicant and the examiner should create an adequate written record of the substance of any interview. However, records can be lost or destroyed, such as by the fire that destroyed the Patent Office on December 15, 1836, or the applicant or the examiner may simply fail to include an important fact in the record that at the time seemed trivial. In this regard, the *Manual of Patent Examining Procedures* recognizes that “[t]he action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through failure to record the substance of interviews.” MANUAL OF PATENT EXAMINING PROCEDURE, *supra* note 47, § 713.04, at 700-107.

<sup>259</sup> See *supra* note 216 and accompanying text.

## VIII. CONCLUSION

A. *Construction of Claim Language: Generally a Matter of Law*

Patents are best analogized to statutes. In terms of Seventh Amendment analysis, this means that no general right to a jury construction of claim language exists.<sup>260</sup> In addition, just as statutory language is interpreted by judges, claim language should be interpreted by judges. Just as judges look at the ordinary meaning and legislative history of a statute to understand statutory language, judges should look at the ordinary meaning of the language in the claims, the specification, and the prosecution history to understand claim language. Thus, by and large, the *Markman* ruling is correct.

The *Markman* ruling can be viewed as a slight modification of the rule in the middle of the road cases in the precedent. Those cases hold that a dispute about the meaning of a term in a claim *does not necessarily* create an issue of fact. Now, under *Markman*, such a dispute *does not* create an issue of fact. The majority of those cases would have come out exactly the same (procedurally and substantively) under the *Markman* ruling. One exception is *Howes*, a case where the prosecution history was in question.<sup>261</sup>

B. *Dispute Regarding Occurrences During Prosecution: A Question of Fact*

A dispute regarding the occurrence of an event during the prosecution of a patent is almost the archetype of a factual issue that should go to a jury.<sup>262</sup> Statutory construction does not involve any analogous type of issue.<sup>263</sup> The different nature of prosecution history as compared to legislative history explains why this discrepancy exists. This discrepancy does not mean that the entire analogy of a patent to a statute is fatally flawed. The discrepancy only indicates that the analogy is not perfect. Therefore, the analogy should not be taken too far, and disputes regarding the occurrence of events in the prosecution of a patent that are not settled by the written record should remain the purview of the jury.

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<sup>260</sup> See *supra* notes 229–34, 248–50 and accompanying text.

<sup>261</sup> See *supra* notes 210–16 and accompanying text.

<sup>262</sup> See *supra* note 216 and accompanying text.

<sup>263</sup> See *supra* notes 251–57 and accompanying text.

### *C. Closing Observations*

In *Markman*, the caveat about disputed events in the prosecution history would not have mattered. No such disputes were present. Instead, a dispute existed about the interpretation of claim language based on the written record. As the foregoing analysis illustrates, this issue is extremely similar to interpretation of statutory language. The patent to statute analogy shows that no Seventh Amendment right to jury interpretation of claim language exists in such a situation. Therefore, in a case such as *Markman*, interpretation of claim language as a matter of law is proper.